

**\*E-FILED 10/12/07\***

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA  
SAN JOSE DIVISION

THE REGENTS OF THE UNIVERSITY OF  
CALIFORNIA,

NO. C 03 05669 JW (RS)

Plaintiff/Counterclaim Defendant,

**ORDER GRANTING MOTION  
TO COMPEL**

v.

MICRO THERAPEUTICS, INC., et al,

Defendants/Counterclaimants and Third  
Party Plaintiffs,

v.

BOSTON SCIENTIFIC CORPORATION, et al.

Third Party Defendants.

Defendants' motion to compel filed on October 11, 2007 has been considered on shortened time pursuant to the parties' stipulation and the Court's order of the same date. The motion is GRANTED. Plaintiff's trial brief states its intention to prove that, "Mr. Dawes went above and beyond his obligations to the PTO during prosecution . . . . Although not required, Mr. Dawes even requested an independent prior art search, incorporating the results of that search into the patent application. No intent to deceive can be found in light of this evidence." Because the fact that Mr. Dawes commissioned an "independent prior art search" is being used as evidence of his good faith, plaintiff has squarely put in issue the materials it claims are privileged. Plaintiff is correct that

1 *relevance* is not a basis for piercing the privilege, but affirmative reliance gives rise to an implied  
2 waiver. See *Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992) (“The privilege  
3 which protects attorney-client communications may not be used both as a sword and a shield.  
4 [Citation.] Where a party raises a claim which in fairness requires disclosure of the protected  
5 communication, the privilege may be implicitly waived.”)

6 Here, plaintiff cannot offer the fact of the search to prove Dawes’s good faith (or, more  
7 precisely, to rebut defendant’s claims of inequitable conduct) while simultaneously shielding  
8 information as to what he may have known about how that search was conducted and other such  
9 matters. Finally, the fact that defendants may have known about the search long ago does not make  
10 the motion to compel untimely, given that it was brought promptly upon plaintiff’s disclosure of its  
11 intent to rely on the search in the manner described above.

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13 IT IS SO ORDERED.  
14 Dated: October 12, 2007

  
15 RICHARD SEEBORG  
16 United States Magistrate Judge  
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**THIS IS TO CERTIFY THAT NOTICE OF THIS ORDER HAS BEEN GIVEN TO:**

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8 Counsel are responsible for distributing copies of this document to co-counsel who have not  
9 registered for e-filing under the Court's CM/ECF program.

10 **Dated: 10/12/07**

**Chambers of Judge Richard Seeborg**

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12 **By: \_\_\_\_\_/s/ BAK**

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